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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,255	11/08/2000	Brett T. Hannigan	P0243	3458

23735 7590 06/10/2003

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EXAMINER

RADA, ALEX P

ART UNIT PAPER NUMBER

3714

DATE MAILED: 06/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/709,255

Applicant(s)

HANNIGAN ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

In response to the amendment filed March 20, 2003 in which the applicant's amend the specification, add claims 21 and 22, and claims 1-22 are pending in this office action.

***Oath/Declaration***

1. In view of the papers filed March 20, 2003, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Tony F. Rodriguez as the forth inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

***Specification***

2. The amendment filed March 20, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: the gesture-decoding module on pages 2-6 of the amendment of paper number 5.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 15-19 fail to describe in the specification how one skilled in the art would sense a gesture from an image data to cause different events or actions to take place.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, the phrase, “sensing a gesture from the image data” is vague and indefinite because the “sensing a gesture from the image data” cannot be determined. How does one sense a gesture?

In claim 16, the phrase, “one gesture causes a page from the book to be read-aloud again” is vague and indefinite because the one gesture causing a page from the book to be read-aloud cannot be determined. How can one gesture cause a page from the book to read-aloud again?

In claim 17, the phrase, “one gesture controls volume of audio” is vague and indefinite because the one gesture controls volume of audio cannot be determined. How does one gesture control volume?

In claim 18, the phrase, “one gesture causes text from the book to be read aloud at a faster speed” is vague and indefinite because the one gesture causing text from the book to be read aloud at a faster speed cannot be determined. How can one gesture cause a text from the book to be read aloud at a faster speed?

In claim 19, the phrase, “one gesture causes text read-aloud from the book to be read using a different voice is vague and indefinite because the one gesture causing a text to be read aloud cannot be determined. How can one gesture cause a text to be read aloud?

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diamond '336 in view of Rhoads '214.

9. Diamond discloses a toy having two eyes, an image sensor having a two-dimensional array of optical sensing elements being positioned to view out of at least one eye, a speaker, and a processor coupled to the image sensor and speaker as recited in claims 1 and 2. The action is music being played back as recited in claim 7.

Diamond does not expressly disclose a steganographic watermark detector for sensing steganographic watermark data on the objects to trigger a response/action. The response to the action is speech-reciting text as recited in claim 3; the speech is assembled from component phonemes or common word recorded by a person (child or child's family member) as recited in claims 4 and 5; the speech phonemes or common words correspond to a celebrity voice as recited in claim 6; retrieving artwork from a data store and printing the artwork for coloring as recited in claim 8; linking to an Internet web site related to a book or subject matter as recited in claim 9; linking to an interactive multiplayer game related to the book or its subject matter as recited in claim 10; the speech incorporates both texts from the book and substitute words as recited in claim 11; the substitute words being retrieved from a local store as recited in claim 12; soliciting words from a child and recording the child's words and using the recorded words as substitute words as recited in claim 13; the substitute words customize the book text to a particular child or locale as recited in claim 14; the sensing of a gesture from the image data and controlling a plurality of different actions as recited in claims 15-20; a book having pages each page being steganographically encoded with plurality bit data, a reading station, a processor, an optical scanner, memory, and a speaker, the processor decoding visible light scan data to decode the plural bit data and accessing stored voice data from memory in accordance with the plural bit data as recited in claims 21-22.

Rhoads teaches a steganographic watermark detectors for sensing steganographic watermark as recited in claims 1 and 2; the speech is assembled from component phonemes or common word recorded by a person (child or child's family member) as recited in claims 4 and 5; the speech phonemes or common words correspond to a celebrity voice as recited in claim 6;

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retrieving artwork from a data store and printing the artwork fro coloring as recited in claim 8; linking to an Internet web site related to a book or subject matter as recited in claim 9; linking to an interactive multiplayer game related to the book or its subject matter as recited in claim 10; the speech incorporates both texts from the book and substitute words as recited in claim 11; the substitute words being retrieved from a local store as recited in claim 12; soliciting words from a child and recording the child's words and using the recorded words as substitute words as recited in claim 13; the substitute words customize the book text to a particular child or locale as recited in claim 14; the sensing of a gesture from the image data and controlling a plurality of different actions as recited in claims 15-20; and a book having pages each page being steganographically encoded with plurality bit data, a reading station, a processor, an optical scanner, memory, and a speaker, the processor decoding visible light scan data to decode the plural bit data and accessing stored voice data from memory in accordance with the plural bit data.

By having a steganographic watermark, one of ordinary skill in the art would be able to fully interactive toy. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Diamond to include a steganographic watermark detector for sensing steganographic watermark, a speech-reciting text, the speech is assembled from component phonemes or common word recorded by a person (child or child's family member), the speech phonemes or common words correspond to a celebrity voice, retrieving artwork from a data store and printing the artwork fro coloring, linking to an Internet web site related to a book or subject matter, linking to an interactive multiplayer game related to the book or its subject matter the speech incorporates both texts from the book and substitute words, the substitute words being retrieved from a local store, soliciting words from a child and

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recording the child's words and using the recorded words as substitute words, the substitute words customize the book text to a particular child or locale, the sensing of a gesture from the image data and controlling a plurality of different actions as taught by Rhoads. To do so would be able to provide universal communication with a variety of basic home or office devices.

### ***Response to Arguments***

10. Applicant's arguments filed March 20 2003 have been fully considered but they are not persuasive.

The applicant contends that that the Diamond reference does not the two-dimension array of optical sensing elements, required by each of claims 1-20.

The Diamond does disclose the equivalent to applicant's optical sensing elements. The eyes of the toy (1) sense the objects to read cards having optical symbols having printed material thereon (figure 3 and 3A-3C).

The applicant contends that the Diamond reference does not disclose a book and several limiting features in the dependent claims not taught by the Diamond reference.

The examiner agrees that the Diamond reference does not expressly teach a book and several limiting features in the dependent claims. However, the Diamond reference was not used to teach a book and several limiting features in the dependent claims. The Diamond reference was merely used for the toy having optical sensors having optical sensing elements. Instead, Rhoads was used to teach the decoding of digital watermark from image data produced by the image sensor and the limiting features in the dependent claims. A good read of the Rhoads reference generally teaches the limitations of the claimed invention.



In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

APL  
apr  
June 9, 2003

  
JESSICA HARRISON  
PRIMARY EXAMINER